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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,619

01/29/2007

Michael Pattemore

AIP-008

8205

45812 7590 06/16/2009  
Law Office of Michael D. Eisenberg  
Intellectual Property Law  
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EXAMINER

LEE, GILBERT Y

ART UNIT

PAPER NUMBER

3676

NOTIFICATION DATE

DELIVERY MODE

06/16/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

meisenberg@mdepatents.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,619	<b>Applicant(s)</b> PATTEMORE, MICHAEL	
	<b>Examiner</b> GILBERT Y. LEE	<b>Art Unit</b> 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-16 and 18, drawn to a seal.

Group II, claim(s) 17 and 19, drawn to a method of producing a seal.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Nolte (US Patent No. 1,356,393) discloses at least the invention of claims 1, 14, 16, and 18.

During a telephone conversation with Michael Eisenberg on 6/4/09 a provisional election was made without traverse to prosecute the invention of group I, claims 1-6 and 18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17 and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Drawings***

2. The drawings are objected to because of the attached PTO-948. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be

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canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "further aperture" of claim 12 and the connection means being a hollow tube of claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities: on Page 1, Line 14 "This process if" should be changed to --This process is--; on Page 2, Line 29 "Preferably the or" should be changed to --Preferably the track or--; on Page 4, Line 22 "their" should be changed to --there--; on Page 5, Line 32 "over" should be changed to --overall--; on Page 7, Line 28 "on the on the" should be changed to --on the--; and on Page 7, Line 30 "allows" should be deleted.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 6, 7, 11, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "rubber-like" in claim 4 is a relative term which renders the claim indefinite. The term "rubber-like" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 6 recites "the track or each is". It is unclear as to what is being claimed. For the purposes of this examination, the examiner is interpreting the claim to be claiming "the at least one track".

Claim 7 recites "the or each track". It is unclear as to what is being claimed. For the purposes of this examination, the examiner is interpreting the claim to be claiming "the at least one track".

Claim 11 recites "at least one aperture"; however, an aperture is already claimed in claim 1. It is unclear as to whether the applicant is trying to claim a second aperture.

Claim 11 recites the limitation "the material strip" in 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 6, 10, 14-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nolte (US Patent No. 1,356,393).

Regarding claim 1, the Nolte reference discloses a seal (14) having at least one aperture (17) through which lubricant can pass (Lines 44-48) and at least one track (19) detachably secured to, and extending along, at least part of the length of at least one surface of the seal (Figs. 1-3).

Regarding claim 2, the Nolte reference discloses the seal taking the form of at least one hollow annular ring (Lines 31-34).

Regarding claim 6, the Nolte reference discloses the track or each being interchangeable with a further track of the same design (Fig. 1). Note that the tracks of the three seals can be interchanged.

Regarding claim 10, the Nolte reference discloses the seal has at least one aperture (17) enabling the lubricant to flow to the track surface (Lines 44-48).

Regarding claim 14, the Nolte reference discloses a seal (14) comprising a chamber (e.g. chamber of 14) for containing lubricant (18), the chamber having a path (e.g. path towards 17) to allow flow of lubricant to an outer surface of the seal so to cool that surface, and the seal having at least one track (19) detachably secured to, and extending along, the length of at least one surface the seal (Figs. 1-3).

Regarding claim 15, the Nolte reference discloses the chamber comprising at least one longitudinal groove (17) formed in the outer surface of the seat.

Regarding claim 16, the Nolte reference discloses a seal (14) adapted to contain a lubricant (18) whose external surface is in part defined by a lengthwise extending track (19) releasably secured to the remaining part or parts of the seal external surface (Figs. 1-3).

Regarding claim 18, the Nolte reference discloses a seal substantially as hereinbefore described as referred to in the accompanying drawings (Figs. 1-3).

7. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Ishitani et al. (US Patent NO. 4,632,403).

Regarding claim 18, the Ishitani et al. (hereinafter "Ishitani") reference discloses a seal substantially as hereinbefore described as referred to in the accompanying drawings (Fig. 4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishitani in view of Nolte.

Regarding claim 1, the Ishitani reference discloses a seal (45) having at least one aperture (45d) through which lubricant can pass (Col. 4, Lines 28-39) and at least

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one track (45e) secured to, and extending along, at least part of the length of at least one surface of the seal (Fig. 4).

However, the Ishitani reference fails to explicitly disclose the at least one track being detachable.

The Nolte reference, a seal, discloses making an attachment member detachable to the seal (Lines 50-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to make the at least one track detachable in the Ishitani reference in view of the teachings of the Nolte reference in order to allow more functionality to the seal and since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

Regarding claim 2, the Ishitani reference, as modified in claim 1, discloses the seal taking the form of at least one hollow annular ring (Fig. 4).

Regarding claim 3, the Ishitani reference, as modified in claim 1, discloses the seal being made from an elastomeric material (Col. 4, Lines 6-16).

Regarding claim 4, the Ishitani reference, as modified in claim 3, discloses the seal being made from a formulated elastomeric compound having resilience such as rubber-like (Col. 4, Lines 6-16).

Regarding claim 5, the Ishitani reference, as modified in claim 4, discloses the seal being formed as an elongated elastomeric extrusion (Col. 4, Lines 6-16). MPEP 2113 Product-by-Process Claims states that "If the product in the product-by-process claim is that same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior art product was made by a different process." Claim 5 is anticipated by the modified Ishitani reference. The process by which the seal is formed is not a patentable distinction.

Regarding claim 6, the Ishitani reference, as modified in claim 1, discloses the track or each being interchangeable with a further track of the same design (Nolte, Fig. 1). Note that the tracks of the three seals can be interchanged.

Regarding claim 10, the Ishitani reference, as modified in claim 1, discloses the seal having at least one aperture (45d) enabling the lubricant to flow to the track surface.

Regarding claim 11, the Ishitani reference, as modified in claim 10, discloses the track has at least one aperture (e.g. apertures of 45e connected to 45d) enabling the lubricant to flow to and into the material strip.

Regarding claim 12, the Ishitani reference, as modified in claim 10, discloses the seal having a further aperture (e.g. aperture of 45 connected to 46) allowing lubricant to pass to neighboring seals, via a connection means (46).

Regarding claim 13, the Nolte reference discloses the connection means taking the form of a hollow tube (Col. 4, Lines 16-21).

Regarding claim 14, the Ishitani reference discloses a seal (45) comprising a chamber (45c) for containing lubricant (Col. 4, Lines 28-39), the chamber having a path (e.g. 46) to allow flow of lubricant to an outer surface of the seal so to cool that surface, and the seal having at least one track (45e) secured to, and extending along, the length of at least one surface the seal (Fig. 4).

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However, the Ishitani reference fails to explicitly disclose the at least one track being detachable.

The Nolte reference, a seal, discloses making an attachment member detachable to the seal (Lines 50-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to make the at least one track detachable in the Ishitani reference in view of the teachings of the Nolte reference in order to allow more functionality to the seal and since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

Regarding claim 15, the Ishitani reference, as modified in claim 15, discloses the chamber comprising at least one longitudinal groove (e.g. 46 or 45d) formed in the outer surface of the seal.

Regarding claim 16, the Ishitani reference discloses a seal (45) adapted to contain a lubricant (Col. 4, Lines 28-39) whose external surface is in part defined by a lengthwise extending track (45e) secured to the remaining part or parts of the seal external surface (Fig. 4).

However, the Ishitani reference fails to explicitly disclose the at least one track being releasable.

The Nolte reference, a seal, discloses making an attachment member releasable to the seal (Lines 50-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to make the at least one track releasable in the Ishitani reference in view of

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the teachings of the Nolte reference in order to allow more functionality to the seal and since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

9. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishitani in view of Nolte as applied to claims 1-6 and 10-16 above, and further in view of Bainard et al. (US Patent No. 4,171,561).

Regarding claims 7-9, the modified Ishitani reference discloses the invention substantially as claimed in claim 1, including the track being made of rubber (Ishitani, Col. 5, Lines 9-12).

However, the modified Ishitani reference fails to explicitly disclose the track having a material strip formed of a fibrous and porous material.

The Bainard et al. (hereinafter "Bainard") reference, a seal for a rotary member, discloses coating a rubber member with a fibrous and porous material (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the track with a material strip in modified Ishitani reference in view of the teachings of the Bainard reference in order to prolong the life of the seal by enhancing the wear properties.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GILBERT Y. LEE whose telephone number is (571)272-5894. The examiner can normally be reached on 8:00 - 4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art  
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